Office - Supreme Court, U. S
FILED
OCT 20 1936
CHARLES ELMORE CROPLEY
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1936.

No. 35.

SAMUEL B. SMITH,
Petitioner,

v.

A. B. HALL and L. C. HALL, d. b. a. HALL BROTHERS,
Respondents.

BRIEF FOR RESPONDENTS.

ARTHUR E. PAIGE,
THOMAS G. HAIGHT,
FRANK E. PAIGE,
Counsel for Respondents.

Lawyers' Book Printing Co., 825 Walnut St., Phila., Pa., Walnut 3781.

INDEX.

Page

THE OPINIONS BELOW 1

THE PARTIES 1

STATEMENT OF THE CASE 2

ARGUMENT 3

POINT I:

The evidence adduced by these Respondents, which convinced the Second Circuit Court of Appeals that Petitioner was not the first inventor or discoverer of the subject matter of his claim 1, was never presented in any Court prior to the present case 3

POINT II:

Every feature and the complete combination, of Petitioner's claim 1, was not only invented and discovered by Milo M. Hastings but disclosed to others and made, used, and sold to Walter B. Davis more than three years prior to the "Spring of 1914", the earliest date alleged by Petitioner for his first conception thereof 6

Claim 1, of the Patent 6

Comparison of Petitioner's Claim 1 with the New Evidence of Respondents 7

Elements of Structure required by said Claim 7

Elements of Operation required by said Claim 8

Page

POINT III:

Every feature, and the complete combination, of Petitioner's claim 1, was not only disclosed to his attorneys Church & Church, by Milo M. Hastings, but clearly described in the Patent Office record of Hastings' application, which is Hall's Exhibit F, prior to the "Spring of 1914", the earliest date alleged by Petitioner for his first conception thereof 9

Hastings' Claim Appealed 12

POINT IV:

Milo M. Hastings had long experience in the art of incubation, and with incubators of various types, before he invented the incubator he made for Davis, and the method of incubation of Petitioner's claim 1 effected therein 14

POINT V:

The drawing, part of Milo M. Hastings' application, Serial No. 264,885, reproduced in Hall's Exhibit F, was merely diagrammatic of the incubator which he built for Walter B. Davis at Brooklyn, and did not purport to be an exact or complete drawing thereof 17

POINT VI:

The percentage of eggs hatched in Hastings' Brooklyn incubator was not only better than obtained from the same grade of eggs hatched in ordinary incubators at the same time and under the same conditions but was "as high as eighty-six per cent. hatches of fertile eggs from yarded stock" 22

POINT VII:

Francis W. Orvis, Editor of Poultry Digest, was not called as a witness by Petitioner in either of the instant Hall and James cases for the reason that he would have confirmed the testimony of the witnesses in the Hall case 24

Page

POINT VIII:

The claim in suit is invalid because of prior inventorship by Milo M. Hastings, Prior Knowledge, Prior Public Use and Prior Sale 25
R. S. 4886 25
Prior Knowledge by Others—Prior Public Use 26
The Method of the Claim in Suit was not only "On Sale" in this Country, but Sold More than Two Years Prior to the Application for the Patent in Suit 28

POINT IX:

The new evidence, in the Hall case, includes the admissions by Petitioner's expert, Joseph I. Taggart, that Petitioner not only failed to disclose in the patent in suit the only way the "method of hatching" of claim 1 may be effected, but specified as an essential of his invention that the eggs be subjected to a certain minimum temperature of air during their early stage of incubation, which, in fact, would be too hot, and "fatal to practically all of the eggs", and that such fatal result could not be avoided by any adjustment of humidity of the air, as argued by Petitioner's Counsel 30

POINT X:

Petitioner's claim 1 in suit is invalid and void because in obtaining the same he did not comply with the specific requirements of R. S. 4888, as to disclosure 33
R. S. §4888 33

POINT XI:

During the long course of litigation of said Smith patent in suit, Petitioner has persistently misrepresented scientific facts concerning incubation and the relation thereof to the disclosures of said patent, in evidence and arguments presented to Courts, including this Court 38

INDEX (Continued).

Page

POINT XII:

Contrary to arguments on behalf of Petitioner, the method of hatching of claim 1 in accordance with his directions is less efficient than was attained in Hastings' incubator at the Davis Poultry Farm and considerably less efficient than the different method of incubation and hatching practiced by the Respondents Hall Brothers 40

This Court Deceived 40

Re Petitioner's "POINT I" 41

PRIOR ART 42

Petitioner's Prior Art Contribution 43

POINT XIII:

Respondents have the right to rely upon disclosures of the Official record of the Hastings abandoned application, found in Halls' Exhibit F, as evidence of prior invention or discovery relative to that of the Smith claim in suit 44

POINT XIV:

No use of a method or process which accomplishes the result sought can be legally classed as an abandoned experiment 47

POINT XV:

Respondents do not infringe 48

CONCLUSION 51

REPRODUCTION OF "DEFENDANT'S EXHIBIT D-D" IN THE COOLEY CASE 52

CASES CITED.

Page

American Gas Accumulator Co. v. Prest-O-Lite Company, 9 F. (2d) 784 36

Beidler v. U. S., 253 U. S. 447 ..... 34, 36
Buckeye et al. v. Cooley, 17 F. (2d) 453 ..... 4, 5
Buckeye et al. v. Stone (D. Oregon, unreported) 5
Buckeye et al. v. Wolf, 291 Fed. 253, 258 4
Buser v. Tufting Mach. Co., 151 F. 478 48
Brush v. Condit, 132 U. S. 39 48

Cleveland Gas Burner Co. v. American Heater Corp., 38 F. (2d) 760 36
Coffin v. Ogden, 18 Wall. 120 17
Columbia Motor Car Co. v. C. A. Duerr & Co., 184 F. 893 37
Consolidated v. Wright, 94 U. S. 92 48
Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 358 46

Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428 36

Egbert v. Lippman, 104 U. S. 333 48
Electro Dynamic Co. v. U. S. L. & H. Corp., 278 F. 80 34
Elizabeth v. Nicholson, 97 U. S. 126 48

Ficklen v. Harding, 273 F. 179 48
Freydberg Bros. v. Hemburger, 17 F. (2d) 300 48

Globe-Wernicke Co. v. Macy Co., 119 F. 696 37

Hale Mfg. Co. v. Hafleigh & Co., 52 F. (2d) 714 36
Health Products Corp. v. ExLax Mfg. Co., Inc., 22 F. (2d) 286 34
Helfreich v. Solo, 59 F. (2d) 525 35

International v. Gaylord, 140 U. S. 55 48

Leonard v. Maxwell, 252 F. 584 34

Matheson v. Campbell, 78 F. 910 34
Midland Flour Milling Co. v. Bobitt, 70 F. (2d) 416 .. 47

Permutit Co. v. Graver Corp., 284 U. S. 51 34

CASES CITED (Continued).

Page

Reflectolyte Co. v. Luminous Unit Co., 20 F. (2d) 607. 36
Roba et al. v. Martin Dennis Co., 263 F. 386 37

Smith v. LeMieux (D. C. Wis., unreported) 40
Smith v. Sims (D. C. Ind., unreported) 4, 5
Smith v. Snow, 294 U. S. 1 ..... 3, 5, 13
Smith & Griggs v. Sprague, 123 U. S., 249 48
Smith v. Street (D. C. Minn., unreported) 4, 5
Smith v. Waxham, 294 U. S. 20 ..... 3, 5
Stelos Co., Inc., v. Hosiery Motormend Corp. et al., 60 F. (2d) 1009 34
Stelos Co., Inc., v. Hosiery Motormend Corp. et al., 295 U. S. 237 35
Steward et al. v. American Lava Co., et al., 215 U. S. 161 36

Thomson Spot Welder v. Ford Motor Co., 268 F. 836; aff. 281 F. 680; aff. 265 U. S. 445 47

United Drug v. Ireland Candy Co., 51 F. (2d) 226 .. 36
U. S. Blind Stitch Mach. Corp. v. Reliable Mach. Works, 67 F. (2d) 327 44

Zenithern Co. v. Art Marble Co., 56 F. (2d) 39 35

R. S. §4886 25
R. S. §4888 33

IN THE

Supreme Court of the United States

October Term, 1936. No. 35.

SAMUEL B. SMITH,
Petitioner,

v.

A. B. HALL and L. C. HALL, d. b. a HALL BROTHERS,
Respondents.

BRIEF FOR RESPONDENTS.

THE OPINIONS BELOW.

The opinion of the Circuit Court of Appeals for the Second Circuit is reported in 83 F. (2d) 217 and in the Hall Record at p. 237. It held invalid claim 1 of the patent in suit, which was the only claim involved in the Hall suit. The opinion of the District Court has not been officially reported. It is found at p. 211 of the Hall Record and held the beforementioned claim valid and infringed.

THE PARTIES.

Petitioner trades as The Smith Incubator Company at Cleveland, Ohio, where he has a "Legal Department" under the supervision of his witness, Joseph I. Taggart, occupied in continued prosecution of several hundred separate suits

involving the same subject matter as the suit against Hall Brothers.

The respondents were, at the time of the institution of this suit, individuals doing business as Hall Brothers. They were operating a farm at Wallingford, Connecticut, where they conducted a large egg incubating plant.

STATEMENT OF THE CASE.

The issues raised in the Court below were limited, at the trial, to the questions of validity and infringement of the claim 1 of Letters Patent of the United States No. 1,262,860 granted April 16, 1918, to the Petitioner, as assignor to The Buckeye Incubator Company, a corporation of Ohio, for Incubator, and alleged to have been re-assigned to the Petitioner subject to a license to, and an agreement with, the original patentee corporation.

The charge of infringement of that claim is based upon the use by Respondents of various different incubator structures manufactured under Letters Patent of the United States Reissue No. 18,984 dated October 31, 1933, granted to John L. Robbins, of Edgewater, Colorado, for Incubator, (upon surrender of original Letters Patent No. 1,728,980 dated September 24, 1929), and purchased by Respondents from the manufacturer, The Robbins Incubator Company, of which the patentee Robbins is the president and proprietor. Said manufacturer has not appeared in this litigation.

The "Brief for Petitioner" raises in this Court both of the questions of validity and infringement of Petitioner's claim 1, and both questions will be considered in this Brief although Respondents' principal contention is that said claim is invalid and void in view of evidence Respondents presented in the District Court below which had not been presented in either of the cases Smith v. Snow or Waxham v. Smith (294 U. S. 1 and 20), or in any other case. That evidence relates to what was done by Milo M. Hastings in

constructing an incubator at Kings Highway and Twenty-third Street, Brooklyn, New York, for Walter B. Davis, in the latter part of the year 1910, and the method of hatching employed in that incubator by Hastings as soon as that incubaor was completed, and in the Spring of 1911 and thereafter, by Hastings and others in the employ of said Davis. The decision of the Court of Appeals for the Second Circuit in the present case held not only Petitioner's claim 1 but also his claims 2, 3, and 5 of the patent in suit invalid and void in view of that prior invention, use, and disclosure by said Hastings, as proven by these Respondents.

Many statements under the heading "Brief History of Hastings" on page 7 of "Brief for Petitioner" dated September 25, 1936, and under the heading "The Hastings Defense in General" on page 16 of said Brief are extensively erroneous as to matters of fact of record, noted infra.

ARGUMENT.

Point I: The Evidence Adduced by these Respondents, Which Convinced the Second Circuit Court of Appeals That Petitioner Was Not the First Inventor or Discoverer of the Subject Matter of His Claim 1, Was never Presented in Any Court Prior to the Present Case.

As stated on page 2 of "Brief for Petitioner", what is termed the "Hastings defense" was neither presented nor considered in either Smith v. Snow or Waxham v. Smith (294 U. S. 1 and 20). It was pleaded in the Snow case but no proofs were presented.

As stated on page 4 et seq. of "Brief for Petitioner", said "Hastings defense" was pleaded in three cases before that of Snow and since the decisions of this Court in the Snow and Waxham cases said defense has been pleaded

in but four U. S. cases, to wit, Smith v. Street, Smith v. Sims, and in the instant James and Hall cases.

Said "Hastings defense" was first pleaded in Buckeye et al. v. Wolf (291 Fed. 253, 258). Judge Westenhaver considered the proofs concerning it inadequate and rendered a judgment against Wolf. That decision of Judge Westenhaver was affirmed by the Court of Appeals for the Sixth Circuit without specific discussion of the Hastings defense (296 Fed. 680).

Said Hastings defense was next presented in Buckeye et al. v. Cooley. Cooley had purchased a second-hand Smith incubator and made a duplicate of every feature of its construction and arrangement. Therefore, his attorneys who, by the way, were not experienced in patent practice, sought to show anticipation of Smith's claims for his incubator **structure**. They had both Hastings and Davis supervise the making of a drawing illustrating said incubator which Hastings had built and operated for Davis. That drawing was offered in evidence as Cooley's Exhibit D-D which is reproduced on the last page of this Brief. Not only Hastings and Davis, but also Edgar Chambless, testified in the Cooley case that said drawing showed the actual construction and arrangement of that incubator which was built in a corner of the cellar of the house on the poultry farm at Kings Highway and Twenty-third Street, Brooklyn, described in Hall's Exhibit G, which was leased by Davis and which house was occupied by him as a roadhouse restaurant, making a specialty of chicken dinners.

As testified by Hastings, Davis, and Chambless, that incubator was six feet long, six feet wide, and more than six feet high, extending from the floor to the ceiling of said cellar. Chambless testified in the Cooley case that he not only saw said incubator during the course of its erection, but observed the operation of incubation and hatching therein repeatedly thereafter, and his testimony is clearly to the effect that staged incubation was practiced

in that incubator by Hastings in the Spring of 1911. See a copy of Chambless' testimony in the Cooley case which is reproduced on pp. 19-20 of this Brief.

It is obvious that said drawing of Hastings' incubator does not show any combination of any of Petitioner's claims for **the structure** of his incubator, and Judge Bodine rendered a decision against Cooley, of which there was no printed report. That decision was affirmed by the Circuit Court of Appeals for the Third Circuit, as reported in 17 F. (2d) at page 453.

The third suit in which said Hastings defense was pleaded was Buckeye et al. v. Stone, and in that case also the evidence concerning it was inadequate. That case was referred to a Master, Mr. Maguire, who recommended judgment against Stone. There was no review of that Master's report by the District Court or the Court of Appeals.

Since the decisions of this Court in the Snow and Waxham cases, said Hastings defense was pleaded in the cases of Smith v. Street and Smith v. Sims and in the Exchequer Court of Canada in the case identified as "1936 Ex. C. R. 105" wherein the Attorney General of Canada sought to impeach the Canadian Patent 217,777 issued to Samuel B. Smith on April 18, 1922, equivalent to Petitioner's patent here in suit. In each of those last three mentioned cases, the Smith patent was held valid, although, as stated at the end of the opinion in said Canadian case, "not unhesitatingly".

However, as above noted, the evidence presented by Respondents in this case was never before presented in any Court. It includes the testimony of Milo M. Hastings, who designed, constructed, and operated the incubator on the poultry farm of Walter B. Davis at Kings Highway and Twenty-third Street, Brooklyn, New York; the testimony of Walter B. Davis, at whose expense said incubator was constructed and under whose supervision it was constructed and operated. Also, the testimony of Mrs. Davis who was at that time not only the Secretary and Book-

keeper for Mr. Davis, who ordered and paid for the materials for the incubator and the eggs to be incubated in it, and paid Mr. Hastings, but also repeatedly inspected the incubator and observed both eggs and hatched chicks in staged incubation in the superimposed trays thereof during its operation.

That incubator remained in the possession of said Walter B. Davis on his farm, after Hastings left his employ, and until the end of the year 1913, when Davis was compelled to vacate said farm, which he had only leased, and as it was too large to be bodily removed from the cellar, it had to be torn to pieces to permit its removal so that he could leave the premises in the condition in which they were leased to him.

Point II: Every Feature and the Complete Combination, of Petitioner's Claim 1, Was Not Only Invented and Discovered by Milo M. Hastings But Disclosed to Others and Made, Used, and Sold to Walter B. Davis More Than Three Years Prior to the "Spring of 1914", the Earliest Date Alleged by Petitioner for His First Conception Thereof.

CLAIM 1, OF THE PATENT.

> "1. The method of hatching a plurality of eggs by arranging them at different levels in a closed chamber having restricted openings of sufficient capacity for the escape of foul air without undue loss of moisture and applying a current of heated air, said current being created by means other than variations of temperature and of sufficient velocity to circulate, diffuse and maintain the air throughout the chamber at substantially the same temperature, whereby the air will be vitalized, the moisture conserved and the units of heat will be carried from the eggs in the more advanced stage of incubation to those in a less advanced stage for the purpose specified."

COMPARISON OF PETITIONER'S CLAIM I WITH THE NEW EVIDENCE OF RESPONDENTS.

Elements of Structure Required by said Claim:

(a) means for supporting eggs "at different levels" in

(b) "a closed chamber having"

(c) "restricted openings"

(d) "means other than variations of temperature" for "applying a current of heated air" throughout the chamber

(e) "means for maintaining the air "at substantially the same temperature".

Each of said elements of structure required by the claim in suit was present in the incubator which Milo M. Hastings built and operated for Walter B. Davis at least as early as the Spring of the year 1911. The testimony adduced by Respondents with reference to said respective elements of structure is as follows:

(a) Testimony of Hastings (Hall Rec. p. 52, f. 78) of Mr. Davis (Hall Rec. p. 59, f. 87); of Mrs. Davis (Hall Rec. p. 62, f. 93).

(b) Testimony of Hastings (Hall Rec. p. 52, f. 78); of Mr. Davis (Hall Rec. p. 58, f. 87); of Mrs. Davis (Hall Rec. p. 62, f. 93).

(c) Testimony of Hastings (Hall Rec. p. 53, f. 80); of Mr. Davis (Hall Rec. p. 58, f. 87); of Mrs. Davis (Hall Rec. p. 62, f. 93).

(d) Testimony of Hastings (Hall Rec. p. 52, f. 78); of Mr. Davis (Hall Rec. p. 58, f. 87).

(e) Testimony of Hastings (Hall Rec. p. 53, f. 79); of Mr. Davis (Hall Rec. p. 58, f. 87-88).

Elements of Operation Required by Said Claim:

(f) "hatching a plurality of eggs"

(g) "escape of foul air"

(h) "applying a current of heated air"

(i) "maintain the air throughout the chamber at substantially the same temperature"

(j) maintaining in the same chamber **during the hatching**, eggs of "more advanced stage of incubation" with others "in a less advanced stage".

(k) carrying "units of heat" "from the eggs in the more advanced stage of incubation to those in a less advanced stage", **during the hatching**.

Each of said elements of operation required by the claim in suit was included in the method of hatching in which the Hastings incubator aforesaid was used in the Spring of 1911. The testimony adduced by Respondents with reference to said respective elements of operation is as follows:

(f) Testimony of Hastings (Hall Rec. p. 52, f. 78-79); of Mr. Davis (Hall Rec. p. 59, f. 87); of Mrs. Davis (Hall Rec. p. 62, f. 92-93).

(g) Testimony of Hastings (Hall Rec. p. 53, f. 80); of Mr. Davis (Hall Rec. p. 58, f. 87); of Mrs. Davis (Hall Rec. p. 62, f. 93).

(h) Testimony of Hastings (Hall Rec. p. 52, f. 78); of Mr. Davis (Hall Rec. p. 58, f. 87).

(i) Testimony of Hastings (Hall Rec. p. 53, f. 79); of Mr. Davis (Hall Rec. p. 58, f. 87-88).

(j) Testimony of Hastings (Hall Rec. p. 52, f. 78; p. 53, f. 80); of Mr. Davis (Hall Rec. p. 59, f. 87); of Mrs. Davis (Hall Rec. p. 62, f. 93).

(k) Testimony of Hastings (Hall Rec. p. 53, f. 79-80); of Mr. Davis (Hall Rec. p. 58, f. 87-89); of Mrs. Davis (Hall Rec. p. 62, f. 93).

We have given the Court a reference to the testimony rather than a recital thereof, because we have thought that on so vital a point the Court would prefer to see the actual testimony of the witnesses rather than counsels' interpretation thereof. The parts of the record thus referred to are comparatively brief. This testimony shows that every element of claim 1 of the patent in suit was conceived, reduced to practice and exhibited to others by Mr. Hastings. As will be subsequently shown, all of this was done at least three years before the earliest date claimed for Smith's conception.

Point III: Every Feature, and the Complete Combination, of Petitioner's Claim 1, Was Not Only Disclosed to His Attorneys Church & Church, by Milo M. Hastings, But Clearly Described in the Patent Office Record of Hastings' Application, Which is Hall's Exhibit F, Prior to the "Spring of 1914", the Earliest Date Alleged by Petitioner For His First Conception Thereof.

Defendants' Exhibit F (Hall Rec. pp. 248-283) is a photographic reproduction of a certified copy of the United States Patent Office records re application Serial No. 624,885 filed May 3, 1911, by Milo M. Hastings for Hatchery for the Eggs of Domestic Fowl. Said application was filed by Milo M. Hastings during the time he was employed by Walter B. Davis in building and operating said incubator at Davis' poultry farm in Brooklyn, New York, beginning in December, 1910, and continuing in 1911. (See Hall Rec. p. 52, f. 78-79, and p. 55, f. 82).

Consequently, that Patent Office record, Defendants' Exhibit F, is documentary evidence contemporaneous with

the events alleged in the testimony of Respondents' three witnesses, Messrs. Hastings and Davis and Mrs. Davis. It discloses every feature of said Smith claim 1, as follows:

> (Hall Rec. p. 250) "My invention is that of a hatchery in which I secure better ventilation and a more uniform temperature throughout the hatching chamber by substituting a forced draft for gravity drafts."
>
> (Hall Rec. p. 251) "Ventilation I secure through cracks around the door of the hatching chamber or other small openings in any part of the air circuit. The air being constantly in motion, requires less rejuvenation than dead air."
>
> (Hall Rec. p. 271) "The problem has been to enable the incubating operations to be carried on continuously, if so desired, with eggs at all stages of development, and with all of a vast number of eggs subjected to the same temperature and atmospheric conditions best adapted for the development of the embryo."
>
> (Hall Rec. p. 272) "In practice it is found that with vast numbers of eggs assembled in a single compartment and with eggs at all stages of incubation but very little extraneous heat need be supplied; because the eggs in the later stages of development supply the necessary heat for the eggs in the earlier stages of development. In practice, however, a source of heat is always maintained in order to permit of proper regulation."
>
> (Hall Rec. p. 273) "The simple way in which applicant overcame the difficulty was through the provision of a mechanically operated air forcing means which would force a rapid circulation of air through the whole collection of eggs in the chamber and past the heater. The mechanical air forcing means is an essential factor, if heat is to be conserved and the

conditions maintained uniform; for a circulation, which is due to differences in temperature in different portions of the circulatory system, as, for example, where the air is circulated by the effect of the heater in causing the heated air to rise and pass into or through the incubating chamber, will not answer for large collections of eggs."

(Hall Rec. p. 275.) "In the Hastings hatchery, a current of air is blown past each and every egg at the rate of thirty feet per minute and this rapidly moving air quickly bringing the temperature of the egg to approximately that of the air. This method of heating keeps the temperature of the eggs in the advanced state of incubation down within a few degrees of that of the air, the exact difference being regulated at will by adjusting the speed of the fan. When properly adjusted the same blast of air used to heat fresh eggs does equally well for eggs in the advanced stages just as the same temperature of the body of the hen incubates the eggs at all stages of development, without recourse on the hen's part to the 'hatching fever', erroneously supposed to explain the higher temperature of eggs at a more advanced stage of development. Owing to this fact eggs at all stages may be handled simultaneously with uniformly good results."

"The operator of a Mechanical Draft plant may switch as much 'fresh' or outdoor air into this inner circulation as he is willing to heat. The inventor's practice is to use but a small portion of outdoor air except in cases of excessive humidity, when a large exchange of air is untilized as a simplest means of increasing evaporation."

(Hall Rec. p. 276) "The introduction of moisture from the mist spray nozzles in the fan boxes to increase humidity, or running in outside air to decrease

it as indicated by egg weights or air cell shrinkage is sufficient for ordinary hatching practice."

It appears from the first two paragraphs above quoted from that Patent Office record, which were in the original application as filed by Hastings, that he considered the most essential feature of his invention to be the circulation in an incubator chamber of a current of heated air by means other than variations in temperature. His attorneys Church & Church evidently agreed with him, for they made no effort to claim for him that feature in association with eggs in staged incubation although not only that combination but its various advantages were clearly disclosed to them, as appears from the other quotations from that record, supra.

Nevertheless, the Official record relating to said application is unquestionable evidence that the invention described in claim 1 here in suit was not only clearly disclosed therein but "known to others" than Smith long before the latter's alleged date of conception thereof in the Spring of 1914; those others including Milo M. Hastings, the five witnesses to his application, to wit, Edgar Chambless and Jeanette Cohen (Hall Rec. p. 251), J. P. Gannon (Hall Rec. p. 252), Walter B. Davis, and Isabel E. Carkhuff (Hall Rec. p. 283, now Mrs. Davis); Hastings' attorneys, Church & Church, and their employes who typed and compared the brief of Church & Church presented to the Board of Examiners-in-Chief; the Primary Examiner, G. R. Ide, and his assistants who prepared and filed the "Examiner's Statement" (Hall Rec. p. 268), and the three Examiners-in-Chief (Hall Rec. p. 280).

HASTINGS' CLAIM APPEALED.

"A hatchery for eggs embodying an incubating chamber adapted for the reception of superposed trays for eggs to be incubated, whereby said eggs

will be arranged in layers one above the other, means for effecting a distribution of air uniformly to the eggs in the chamber, means for heating the air, and mechanically operated means for forcing a uniform circulation of air through all parts of the chamber and past the heater, whereby convexion currents will be eliminated, temperature and gaseous stratification of the air in the chamber overcome, and the eggs subjected to the influence of air of the same temperature and composition."

As noted at the end of the decision of said three Examiners-in-Chief (Hall Rec. p. 280), one of them agreed with the appellant, Hastings, that said claim was patentable to him. It is obvious that it is broader than Petitioner's claim 1, and, consequently, Petitioner could not have used his invention without infringement of that claim if it had been granted to Hastings.

In accordance with the reasoning of this Court in the **Snow** case (294 U. S. 1), Plaintiff's Exhibit 2, Hall Rec. p. 98), Hastings' application should have been allowed and Letters Patent granted to him instead of to the Petitioner who adopted Hastings' invention after it was in public commercial use and articles concerning it widely published (Hall Rec. pp. 63-64, f. 94-95) in periodicals of the poultry industry of which there are numerous examples (pp. 296-300, 302-303) in the Transcript of Record of the **Cooley** case, of which Defendants' Exhibit F is a part. Of course, Hastings forfeited his right to obtain Letters Patent for the invention in question by abandoning his application, but, he abandoned it to the public generally and not to the Petitioner Samuel B. Smith exclusively.

Hastings prepared said application himself, when but twenty-seven years old, and without any previous experience in such matters. Consequently, the application papers which were filed in the Patent Office on April 25, 1911, were objected to as informal, and his application was not

accepted for filing until he had corrected those informalities on May 3, 1911. It may be observed that the Official letters to Hastings during the prosecution of said application were addressed to him at the address of the Davis Poultry Farm where he was operating the incubator in accordance with the new evidence aforesaid.

Point IV. Milo M. Hastings Had Long Experience in the Art of Incubation, and With Incubators of Various Types, Before He Invented the Incubator He Made for Davis, and the Method of Incubation of Petitioner's Claim 1 Effected Therein.

Following the heading "Point II" on page 16 of "Brief for Petitioner", is a labored attempt to discredit Milo M. Hastings, by assertions to the effect that he was ignorant of the art of incubation and unable to recognize the difference between **refrigeration of vegetables** and **incubation of eggs**. Such assertions are ridiculous in view of the evidence of record, for instance, in the Cooley case, with which the authors of said Brief claim to be familiar.

The uncontradicted testimony in the Transcript of Record in the Cooley case, (see Hall's Exhibit F, p. 75, et seq.) is that when Milo M. Hastings was but twelve years of age, in 1897, he constructed an incubator in which the source of heat was a lamp. That during the next few years he operated commercial incubators of the lamp type, such as were then in common use. That in the Summer of 1902 he was employed on a poultry farm at Belleview, Illinois, and there operated incubators. That in the Fall of 1902 he was a student in the Kansas State Agricultural College at Manhattan, Kansas, where he was "given full charge of the chicken work at the experiment station", operating under the direction of the dairy department of said College. That during the college year, 1902 and 1903, he was "the poultry man in charge of the poultry at the College Station on the college campus."

That in the following years, to 1906 inclusive, he was teaching school. That while thus engaged as a student and instructor in poultry work at said College, he "conducted the first experimental station egg laying contest in the United States, and had general charge of poultry work at the college, which included the incubating during the season" which was effected in incubators of "several makes" including the "Cyphers" which "was the prevailing lamp machine at that day". That after graduation from college in 1906, Hastings came East and was engaged in other work until January 1, 1908, at which time he received an Official appointment in the United States Department of Agriculture, Bureau of Animal Industry, and was assigned to conduct "a **general survey of the poultry industry and with special application to the marketing of eggs.**"

That he traveled in thirty-six of the United States, "visiting most of the experiment stations, the marketing centers, the produce houses, the packing houses, the large poultry farms for the purpose of preparing a bulletin thereon." That he was "stationed in Chicago for a month or more in the Winter of 1908, specially studying the cold storage of eggs." That during that time he invented an instrument called "a cold storage evaporimeter" which was patented by the Department of Agriculture. That patent is No. 911,875 granted February 9, 1909, to Milo M. Hastings for Apparatus for Measuring the Humidity in or Determining the Evaporating Power of the Air", and a copy of it is Hall's Exhibit I appearing in Hall Rec. p. 210-A,

That in the course of that investigation, Hastings' attention was called to Letters Patent of the United States No. 754,749 granted to Madison Cooper for Cold Storage Apparatus. That "As described in the patent, the purpose of this circulation of cooled air by a fan was to maintain an equal and well distributed uniform temperature in the chamber for the *purpose of storing eggs*". That later in the year 1908 he visited Madison Cooper at his home in Watertown, New York, and "consulted with him about the

use of the same device for the *purpose of incubating* **eggs.**" (Italics ours.) [See note.]

There is no mention of "vegetables" in said Cooper patent 754,749 which is reproduced in pages 365 to 371 inclusive of the Cooley Record, (Hall's Exhibit F). Therefore, the disparaging statement in line 21 et seq. on page 7 of said "Brief for Petitioner", to the effect that the incubator which Milo M. Hastings testified he built in 1910, and operated in 1911 at the poultry farm of Walter B. Davis, in Brooklyn, New York, was copied from "Apparatus developed by one Madison Cooper for the preservation and **cold storage of vegetables**" is erroneous. Moreover, the numerous disparaging statements in said "Brief for Petitioner" as to Hastings' selfish interest in the premises, are contradicted by the evidence certainly known to Petitioner's Counsel.

In fact, the attitude and conduct of Milo M. Hastings, in his prolonged efforts to benefit the poultry industry, appearing from abundant Official records, are in sharp contrast with the attitude and conduct of Petitioner Smith who, having received Letters Patent for the claim here in suit, for an invention which was not his, but Hastings', proceeded, and is continuing, to use it as an instrument of terrorism in the continued prosecution of several hundred suits against defendants engaged in that industry, since the expiration of Petitioner's patent here in suit, although fully aware that his complaints in all of said suits are devoid of equity.

Note: After that consultation between Milo M. Hastings and Madison Cooper, the latter designed for Rolla Lawry, of Missouri, the incubator which was built by Lawry and successfully operated under his direction and to which Judge Bodine referred in his decision in the Hillpot case (22 F. (2nd) 857) "Rolla Lawry probably completely anticipated Smith, but his anticipation need not now be considered".

Point V: The Drawing, Part of Milo M. Hastings' Application, Serial No. 264,885, Reproduced in Hall's Exhibit F, Was Merely Diagrammatic of the Incubator Which He Built for Walter B. Davis at Brooklyn, and Did Not Purport to be an Exact or Complete Drawing Thereof.

That drawing shows a box which is about three times as long as it is high, as shown by the illustrations (Hall Rec. p. 283) and on page 24 of "Brief for Petitioner" the door and vestibule leading to the egg chambers being omitted.

On page 24 of "Brief for Petitioner" it is stated:

> "This drawing made by Hastings and incorporated by him in his patent application was made at about the time when he completed the Davis or Brooklyn incubator. Therefore, it seems only reasonable to assume that it represents what Hastings then had in mind as the best embodiment of his ideas about incubator construction, *and the construction he employed in building the Hastings incubator.*" (Italics ours.)

That is obviously untrue, as is evident from even a casual comparison of that drawing as reproduced on Hall Rec. p. 283, with said Cooley's Exhibit D-D drawing, reproduced at the end of this Brief, which witness Chambless testified, pages 19-20 infra, accurately illustrates the incubator which Hastings built for Davis at Brooklyn, and with which Chambless was entirely familiar as he testified. Hastings' application drawing is a mere diagram illustrating what he understood to be the novel features of his invention as described in the claim of that application which he formulated without any knowledge or experience in such matters.

Counsel for Petitioner must have forgotten temporarily the admonition of this Court that "The law requires

not conjectures but certainty." (Coffin v. Ogden, 18 Wall. 120) cited in their "Brief for Petitioner", p. 14. Their conjectures above quoted are expressly denied by the certainty of the testimony of Chambless with reference to the Cooley Exhibit D-D. (Pages 19-20, infra.)

On page 25 of "Brief for Petitioner" it is conjectured that the incubator which Hastings built for Davis in 1910, as aforesaid, and began to operate early in 1911, included "fabric panels" such as indicated at the top and bottom of the egg chamber on page 24, and Counsel for Petitioner elaborate on that theory an argument to the conclusion, at the middle of page 26 of said Brief, that "this Brooklyn hatchery lacked the forced current circulation of air through a large mass of eggs with sufficient velocity to maintain and equalize the temperature throughout."

All such conjectures, theories and conclusions are negatived by the uncontradicted evidence of record, for instance, in the Cooley case, Milo M. Hastings testified, "Transcript of Record" (Hall's Exhibit F) p. 136 et seq., as follows:

> "XQ212. And you had never used such a perforated partition or fabric or anything of the kind with this Davis Hatchery? A. I cannot say that I might not have used fabrics in that hatchery, but I did not use them throughout the hatching season.
>
> XQ213. What is your best recollection as to whether you did use fabric or did not? A. My recollection is that in trying out the circulation of air through that chamber before incubating eggs in it, that I introduced fabrics and found they checked the flow of air too much, hence discarded them."

That testimony was confirmed by the testimony of witness Edgar Chambless, above mentioned, with reference to Cooley's Exhibit D-D, to wit, the drawing of said Brooklyn incubator, which was made under the supervision

of both Hastings and Davis as witnesses in that case, and does **not** include any such fabric panels, and was declared by Chambless to be an accurate illustration of that incubator. (See pages 19-20, infra.)

As appears on page 251 of Hall's Record, Hastings' application for patent for Improvement in Hatchery for the Eggs of Domestic Fowl" was witnessed by "Edgar Chambless". He was called as a witness in said Cooley case and as appears on page 169 of the Transcript of Record in that case (Hall's Exhibit F), testified concerning the hatchery built by Hastings for Davis, as follows:

"Q20. Did you see the hatchery while it was being built? A. Yes, sir.

Q21. Did you see it after it was completed? A. Yes, a number of times.

Q22. Did you see it in operation? A. Yes, sir.

Q23. I hand you Defendant's Exhibit D, and ask you to state whether or not you recognize what is shown therein? A. Yes, I recognize it very distinctly.

Q24. As what? A. As being the hatchery built by Mr. Hastings at Mr. Davis' place, and located in his basement or cellar.

Q25. And does this drawing that you have just looked at correctly illustrate the construction and arrangement of the various parts that entered into this Davis hatchery? A. I would say it is quite accurate.

Q26. Did you see any hatches coming off from this Davis hatchery while it was being operated by Mr. Davis? A. Oh, yes, a number of times.

Q27. Do you know of your own knowledge how long Mr. Hastings operated that hatchery? A. Why, no, I don't remember, a month or so at least.

Q28. Do you recall about the size of that hatchery? A. What?

Q29. About the size of the hatchery? A. Oh, yes,

I was inside of it, it was—I could walk into it without stooping. It must have been around seven feet, I suppose, high, and about six feet square, six feet in breadth and width, and about seven feet high, maybe a little taller. I don't remember the exact height.

Q30. Did you visit that plant often enough to determine for yourself whether the character of the hatches was good, bad or indifferent? A. Why, I went out on week ends at least a half a dozen Saturdays, and stayed over from Saturday to Sunday, and there were hatchings coming out almost every time I went out. I went out partly because I felt interested in this demonstration."

Certainly, the answer of Chambless to Q30 above quoted, is evidence that staged incubation was practiced in the Hastings' incubator made for Mr. Davis at Brooklyn, in 1910, and operated in 1911, and confirmed the testimony of Hastings and Davis in the Cooley case and also the above cited testimony of Hastings, Davis, and Mrs. Davis in the Hall case.

Moreover, on page 253 of the Transcript of Record in the Cooley case (Hall's Exhibit F), there is an illustration entitled "A. Exterior. B. Interior." That is a reproduction of respective snapshots in overlapped relation. The exterior photograph "A" shows at the right the exterior door of Hastings' incubator at the Davis Poultry Farm, which door is indicated at the left-hand side of the upper left-hand illustration in said Cooley drawing Exhibit D-D which is reproduced at the end of this Brief. The rectangular dark spot above the letter "A" on that photograph is the outlet for the fumes from the gas heater, which outlet is indicated at I in the illustration A-2 on said Cooley Exhibit D-D, which is described in the testimony of Milo M. Hastings on page 81 of the Transcript of Record in the Cooley case thus:

"There is an exit for the fumes from the gas flames, that we will mark I."

The photograph "B" aforesaid shows the interior of that incubator at the Davis Poultry Farm with adjoining egg trays pulled out into the corridor and showing in the nearest tray all white eggs and in the adjoining tray marked "B" black chicks emerging from white egg shells. Certainly, that is unmistakable evidence of staged incubation in that incubator.

Edgar Chambless testified that he made said photographs in the Spring of 1911. His testimony appears on page 171 of the Transcript of Record in the Cooley case (Hall's Exhibit F), as follows:

"Q35. I draw your attention to the illustrations found on page 12 of Defendant's Exhibit C, and ask you to state whether you can recognize the same? A. Yes, this is an exact—this is a photograph of that hatchery, I made it.

Q36. In the Spring of 1911? A. Yes."

We submit that such testimony and contemporaneous records are overwhelming evidence of the employment of staged incubation in the incubator which Hastings erected for Davis at Brooklyn in 1910 and operated in 1911 and that such evidence is fully known to Counsel for Petitioner who have presented voluminous argument to the contrary in the present "Brief for Petitioner".

Point VI: The Percentage of Eggs Hatched in Hastings' Brooklyn Incubator Was Not Only Better Than Obtained From the Same Grade of Eggs Hatched in Ordinary Incubators at the Same Time and Under the Same Conditions But Was "as High as Eighty-six Per Cent. Hatches of Fertile Eggs From Yarded Stock".

On page 35 of "Brief for Petitioner" it is stated:

> "Also, analysis of the asserted operative success reduces it to nothing more than the fact that the Hastings incubator at the Davis farm produced chicks from eggs. Whether or not it produced them cheaper or better or in a way that was an improvement in any other respect is not proven, and the fact that it was capable of producing chicks from eggs is quite unimportant because there were plenty of available incubators at the time which would do that."

That "analysis" is contrary to the evidence of record; for instance, in the Cooley case, Exhibit D-C includes on page 252 of the "Transcript of Record" which is Hall's Exhibit F, a letter dated April 10, 1911, from Walter B. Davis, who was a witness in that case, which letter is as follows:

"DAVIS POULTRY FARM,
Kings Highway and East 23rd St.,
Brooklyn, New York.

April 10, 1911.

To whom it may concern:

This is to certify that Prof. Milo M. Hastings has built and operated upon my poultry plant a mammoth incubator or hatchery, and that the results from same have equalled or surpassed the results from competing Cyphers incubators, which are considered as the leading make of small hatchers.

The Hastings Hatchery has been running continuously upon my farm for about two months without

serious mishap or failure, yielding as high as eighty-six per-cent. hatches of fertile eggs from yarded stock, which I consider very good indeed.

Even with the small scale upon which we have operated and with the handicap of initial construction expense this hatchery has been much cheaper to build and operate than the prevailing type of incubators. I see no reason why this expense could not be greatly reduced and completely out-distance small incubators for large plants.

(Signed) Walter B. Davis,
Proprietor, Davis Poultry Farm."

That contemporaneous written record of the result of use of the Hastings incubator, and method of incubation, under the supervision of Davis in the Spring of the year 1911, which was published at that time, controverts the erroneous conjectures of Counsel for Smith in said Brief.

Moreover, as shown in that same Hall's Exhibit F, page 254, there was offered in evidence as part of Cooley's Exhibit D-C, a copy of a letter dated May 20, 1911, from Francis W. Orvis, Editor of the Poultry Digest, then being published at 57 Ann Street, New York City, and as follows:

"POULTRY DIGEST
57 Ann St.,
New York City.

May 20, 1911.

To Whom it may concern:

The writer has visited the plant of Walter B. Davis in Brooklyn, N. Y., where Mr. Milo Hastings is operating a unique device which he hopes will simplify the hatching problem.

A small room was so arranged that with the various devices of Mr. Hastings', heat, moisture and ventilation were under perfect control and the eggs and

chicks were as easily accessible as in the opening of a bureau drawer. The little fellows were coming out and new eggs added daily, making a continuous hatching proposition under absolute control of the operator.

The percentage of eggs hatched the day the writer visited the plant was somewhat better than obtained from the same grade of eggs hatched in ordinary incubators running at the same time and under the same conditions.

Mr. Hastings 'hatchery' will probably do for the poultry business what the separator has done for the dairy business.

(Signed) Francis W. Orvis,
Editor, Poultry Digest."

Certainly that letter describes staged incubation being practiced in that Brooklyn incubator, and confirms said testimony of Chambless, in the Cooley case, and the testimony of Hastings, Davis, and Mrs. Davis, in the present case.

Point VII: Francis W. Orvis, Editor of Poultry Digest, Was Not Called as a Witness by Petitioner in Either of the Instant Hall and James Cases for the Reason That He Would Have Confirmed the Testimony of the Witnesses in the Hall Case.

On page 22 of "Brief for Petitioner" it is asserted concerning Milo M. Hastings, "He first disclosed his idea to Francis W. Orvis, the Editor of 'Poultry Digest' who was not called as a witness by the defense in either case and whose absence was not explained". "Neither Miller nor the helper was called as a witness by Respondents, nor was their absence accounted for".

Counsel for Hall Brothers informed the Court below that we made a diligent search for Orvis, Miller, and said helper with the result that we were credibly informed that they were dead.

It was not until Petitioner's Counsel Albert L. Ely, Edmond M. Bartholow, and Geo. C. McConnaughey filed their Brief on appeal in the United States Circuit Court of Appeals for the Second Circuit that they disclosed in line 3 et seq. on page 16 thereof "As a matter of fact Orvis is alive today and lives in Hackensack, N. J."

Why did not Petitioner's Counsel call Orvis as a witness to contradict the testimony of Respondents' three witnesses Milo M. Hastings, Walter B. Davis, and Mrs. Davis? The answer is that if called Orvis would have corroborated the testimony of said witnesses, as is clearly indicated by the letter of "Francis W. Orvis, Editor, Poultry Digest" dated **May 20, 1911**, reproduced on page 254 of the Cooley record including your Respondents' Exhibit F, and above quoted, (pages 23, 24), wherein Orvis described the incubator which he had inspected at the farm of Walter B. Davis and staged incubation he saw therein.

Point VIII: The Claim in Suit is Invalid Because of Prior Inventorship by Milo M. Hastings, Prior Knowledge, Prior Public Use and Prior Sale.

R. S. §4886 is as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

The testimony of Hastings and Mr. and Mrs. Davis is clearly to the effect that the invention of the claim in suit was not only known to others in this country long before the Petitioner Smith's alleged conception thereof, in the "Spring of 1914" but was in long continued public and successful commercial use, in this country, more than two years prior to Petitioner's application for the patent in suit, which was not filed until October 26, 1916.

PRIOR KNOWLEDGE BY OTHERS PRIOR PUBLIC USE.

Milo M. Hastings' invention of the subject matter of claim 1 of the patent in suit was not only known to others in this country, as evidenced by Defendants' Exhibit F where the names of **eleven** of them appear, as noted on page 12, supra, but was known to many hundreds of people who visited the poultry farm of Respondents' witness Walter B. Davis while Hastings was there employing that method of hatching in the incubator which he had erected for Davis.

Defendants' Exhibit G is a booklet entitled "Davis Poultry Farm" published and copyrighted in 1911, and is not only evidence that Davis had and was actively conducting a comparatively large poultry business in the year 1911 but that the public was invited to inspect and did inspect the equipment of that poultry business which Davis conducted on a rented property at Kings Highway and 23rd Street, in Brooklyn, New York, which was the address of Milo M. Hastings, as shown by the Official letters in Defendants' Exhibit F (Hall Rec. pp. 248, 254, 256, 259).

Exhibit G contains an express invitation to the public to inspect the facilities Davis had for the production of poultry, and Davis testified (Hall Rec. pp. 57-58, f. 86-87) that an edition of 2000 of those booklets was distributed and that, in response to the invitation therein, "thousands"

of people visited his farm and examined the equipment thereof. Hastings testified (Hall Rec. pp. 53 and 54, f. 80-81) "The catalog states 'Visitors Welcome'. • • • I remember seeing that catalog in circulation and given out", and that the eighth page thereof shows a photographic reproduction of a picture including said Mr. Orvis (Francis W. Orvis), to whom Hastings explained his invention before meeting Walter B. Davis.

The testimony of Messrs. Hastings and Davis and Mrs. Davis agrees that the building in which said incubator was erected in accordance with Hastings' design and under his supervision and in which his method of hatching was successfully practiced for a considerable period of time (Hall Rec. p. 52, f. 78-79, p. 59, f. 88-89, and p. 60, f. 89) was used not only as a residence but as a roadhouse where "thousands" of visitors were entertained (Hall Rec. p. 58, f. 87, p. 60, f. 90). Mr. Davis mentioned the fact that upon one occasion he slaughtered over 200 chickens to feed the visitors who had responded to his invitation (Hall Rec. p. 60, f. 90).

Every expression of Milo M. Hastings, cited by Counsel for Petitioner as supporting their argument that the Brooklyn incubator was "carefully guarded from the public", as alleged in lines 9 and 10 on page 9 of said "Brief for Petitioner", was in fact expressly limited to time prior to the filing of his application for patent. (Hall Rec. p. 56, f. 84.)

Therefore, it is submitted that Respondents have clearly proven the fact that the method of hatching described in Smith's claim 1 in suit was not only "known to others" but in "public use" and repeatedly successfully used on the Davis poultry farm at least three years before the Spring of 1914, the date of conception of the subject matter of claim 1 in suit alleged by Petitioner.

The testimony of Mr. and Mrs. Davis agrees that owing to serious financial losses incident to his investment in an aviation project (Hall Rec. p. 60, f. 89; p. 63, f. 93)

Mr. Davis was compelled to terminate, at the end of the year 1913 (Hall Rec. p. 60, f. 89) his lease of said premises at Kings Highway and 23rd Street, Brooklyn, and consequently relinquish his poultry business there conducted, and thereafter occupy himself with his linotype printing business. That Mr. Davis was able to remove the four Cyphers incubators forming part of the poultry producing equipment on said premises and thus salvage them because they were portable (Hall Rec. p. 61, f. 91). That Mr. Davis was unable to remove the incubator which he had bought from Mr. Hastings which was not only too large to remove intact (Hall Rec. p. 61, f. 91) but was built into the cellar so that it was necessary to tear its wooden walls to pieces to get it out in order to restore the premises to the condition in which he rented them. Therefore, said Hastings incubator was thus destroyed, but not until December, 1913 (Hall Rec. p. 60, f. 89).

THE METHOD OF THE CLAIM IN SUIT WAS NOT ONLY "ON SALE" IN THIS COUNTRY, BUT SOLD MORE THAN TWO YEARS PRIOR TO THE APPLICATION FOR THE PATENT IN SUIT.

Respondents have proven by the testimony of their witnesses Milo M. Hastings, Walter B. Davis, and the latter's wife, that **before** Hastings had filed his application aforesaid for Letters Patent of the United States, he not only had the invention subject matter of Smith's claim in suit in notorious public use but "on sale in this country for more than two years prior" to the application of Smith for the patent in suit, which was not filed until October 26, 1916.

Hastings testified (Hall Rec. p. 54, f. 80-81) that he had explained to Francis W. Orvis, then editor of the periodical "Poultry Digest" published at 57 Ann Street, New York City; (see p. 254 of the Cooley Transcript of Record containing Defendants' Exhibit F) his method of

hatching subseqnently disclosed in said Official record of his application for Letters Patent, and that testimony of Hastings and of Davis (Hall Rec. p. 58, f. 88) agrees in that Orvis introduced Hastings to Davis for the purpose of having the latter acquire and use that invention on his poultry farm which is described and illustrated in the booklet entitled "Davis Poultry Farm", which is Defendants' Exhibit G.

The testimony of Hastings (Hall Rec. p. 52, f. 78; p. 54, f. 81; p. 56, f. 85) and Davis (Hall Rec. p. 59, f. 88) agrees in that the arrangement between them was that Davis paid for the materials necessary for the construction of an incubator in accordance with Hastings' ideas and also paid Hastings a monetary consideration for his services in supervising that construction, which was also payment to Hastings for the continued right of Davis to use Hastings' method of hatching aforesaid in that incubator structure.

The testimony of Hastings (Hall Rec. pp. 56-57, f. 85) confirmed by both Mr. Davis (Hall Rec. p. 59, f. 88) and Mrs. Davis (Hall Rec. p. 62, f. 92) is that Hastings received from Davis the full amount of such consideration agreed upon. Hastings thus effected a sale of his invention within the meaning of R. S. 4886 both as to his incubator structure and the method of hatching, certainly as early as the Spring of 1911, and thus **three years before** the date alleged by the Petitioner Smith as the date of conception of his invention of claim 1 here in suit, to wit, the "Spring of 1914".

Point IX: The New Evidence, in the Hall Case, Includes the Admissions by Petitioner's Expert, Joseph I. Taggart, That Petitioner Not Only Failed to Disclose in the Patent in Suit the Only Way the "Method of Hatching" of Claim 1 May Be Effected, But Specified as an Essential of His Invention That the Eggs Be Subjected to a Certain Minimum Temperature of Air During Their Early Stage of Incubation, Which, in Fact, Would Be Too Hot, and "Fatal to Practically All of the Eggs", and That Such Fatal Result Could Not Be Avoided by Any Adjustment of Humidity of the Air, as Argued by Petitioner's Counsel.

The only information, in said patent in suit, as to the temperature **of the air** to be maintained during the method of hatching of Petitioner's claim 1, is in the statement in line 40 et seq. on page 1 of said patent, as follows:

> "The temperature of circulating air should be such as will prevent the eggs in the early stage of incubation from falling below 100°."

That statement is untrue for, as admitted by Petitioner's witness Taggart (Hall Rec. pp. 46-47, f. 70-71), the air must be at a temperature of at least 100½° F., perhaps 100¾° F., to prevent the eggs in the early stage of incubation from falling below 100° F., and, as admitted by Taggart (Hall Rec. p. 47, f. 71-72), "if you subjected eggs to such a temperature of air that they do not fall below 100° F. in the early stage or first ten days, *it would be fatal to practically all of the eggs.* That was my discovery. In the Waxham case I testified that '*Even with the proper humidity,* 99¼° is too hot for a Smith incubator'." (Italics ours.)

Therefore, it is unquestionable, in view of the testimony of the Petitioner's own witness Taggart, that the success or failure of the method of hatching, subject matter of claim 1 in suit, is dependent upon precise determination and maintenance of the critical correct temperature

of the air less than 99¼° F. in the closed chamber where incubation is being effected, but the patent in suit not only fails to afford that information, but clearly and specifically directs the performance of the method under different conditions at a higher temperature which said witness Taggart admits would be "fatal to practically all of the eggs". The reasonable inference is that the Petitioner Smith himself did not know, even as late as the issuance of his patent on April 16, 1918, that an air temperature of 99° F. must be maintained in the "closed chamber" to effect the method of hatching of claim 1 in suit.

That reasonable inference is made a certainty by the testimony of Petitioner's witness Taggart (Hall Rec. p. 48, f. 72) that it was not until the year 1923 that he Taggart, by a series of experiments and tests, determined and disclosed to Smith incubator users that the teaching of the patent in suit was erroneous, and that the maximum temperature of the air which it was safe to use in the method of hatching of claim 1 in suit was but 99° F. as he testified (Hall Rec. p. 47, f. 71-72) "Even with the proper humidity, 99¼° is too hot for a Smith incubator".

It appears from the foregoing comparison of the disclosures of the patent in suit with the scientific facts to which Petitioner's witness Taggart testified, that Smith not only failed to disclose the correct use of the incubator structures disclosed in his patent, but gave clear and specific instructions for use thereof which are not only misleading but fatally defective.

Note: In view of the argument on pages 87, 88 and 89 of "Brief for Petitioner" to the effect that the fatal result of following the Petitioner's instructions in the patent in suit as aforesaid, might be avoided by proper humidity of the air in the incubator; it is noted that Petitioner's Counsel Albert L. Ely sought to have his witness Joseph I. Taggart support that contention by his testimony, but Taggart was too honest to do so and testified as aforesaid (Hall Rec. p. 45, f. 71-72), "Even with the proper humidity, 99¼° is too hot for a Smith incubator."

Consequently, Petitioner's method claim 1 is invalid and void because his disclosures in the patent in suit as to the operation of the **only incubator** therein shown are not only insufficient to effect the method of hatching contemplated in said claim, but would prevent any **hatching** of eggs treated in the manner prescribed in the patent in suit.

In that argument, on page 88 of "Brief for Petitioner", is the adroit statement: "Up to 1928 when the higher humidity came into general use, Smith and his licensee, The Buckeye Incubator Company, had operated successfully over a long series of years at temperatures within the range stated in the specification (Hall Rec. p. 49)." That statement is not supported by the record cited.

There is no "range" of temperature of **air** stated in the Petitioner's patent specification. The only range stated is in line 15 et seq. on page 1 of said patent, as follows:

> "There is a forced circulation of hot air through the chamber which is adapted preferably to *maintain all eggs* at temperatures between 100° and 105° Fahrenheit approximately" (italics ours).

As clearly and specifically stated by Petitioner's witness Taggart, to follow that instruction would be "fatal to practically all of the eggs". It appears from Taggart's testimony (Hall Rec. p. 47, f. 72) that he sought to excuse the fatal instructions given by Petitioner in his patent on the ground that Petitioner was ignorant of the actual facts.

Said argument implies that the method of hatching, subject matter of Petitioner's claim 1, has been effected in accordance with the specific instructions of the patent in suit. In accordance with the explicit instructions found in line 40 et seq. on page 1 of said patent

"The temperature of circulating air should be such as will prevent the eggs in the early stage of incubation from falling below 100°."

As clearly and explicitly testified by Petitioner's expert Taggart, such procedure would have been "fatal to practically all of the eggs". Within Taggart's knowledge, it was **never** practiced, even experimentally. (Hall Rec. p. 47, line 1 et seq.)

It is a weird proposition, advanced in "Brief for Petitioner", that the specification of the patent in suit is to be disregarded in the consideration of claim 1 thereof based upon that specification, and Petitioner's erroneous instructions in the specification as to the conditions necessary for the conduct of the method of hatching of claim 1 though false and fatal, should be excused and Petitioner's patent held valid because, as they assert, Petitioner was ignorant of the scientific facts pertaining to incubation.

Point X: Petitioner's Claim 1 in Suit is Invalid and Void Because in Obtaining the Same He Did Not Comply With the Specific Requirements of R. S. 4888, As to Disclosure.

R. S. 4888. "Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that

principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses."

In support of Respondent's contention as to invalidity of the Smith claim in suit for lack of disclosure, attention is called to the following decisions:

In Health Products Corp. v. Ex-Lax Mfg. Co., Inc., 22 F. (2d) 286, the Circuit Court of Appeals for the Second Circuit held that the specification of a patent must be more than a suggestion for promising experiment, and that the specification must contain complete directions leading with certainty to result. Citing Matheson v. Campbell, 78 F. 910, 916 (C. C. A. 2d); Leonard v. Maxwell, 252 F. 584; 590 (C. C. A. 2d); Electro Dynamic Co. v. U. S. L. & H. Corp., 278 F. 80, 84 (C. C. A. 2d).

In Permutit Co. v. Graver Corp., 284 U. S. 51, the Supreme Court stated that a patent which fails to describe in the specification the principle of the apparatus in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, then such patent is void.

In Stelos Co. Inc. v. Hosiery Motormend Corp. et al., 60 F. (2d) 1009, the Court held that it is settled law that disclosure of a patent must be so clear as to enable an ordinary workman skilled in the art to practice the invention without further experiment. Citing Beidler v. U. S., 253, U. S. 447, 453. Health Products Corp. v. Ex-Lax Mfg. Co., Inc., 22 F. (2d) 286, 287 (C. C. A. 2d). The Court states that the reason for this is that the disclosure of a patent is not addressed to persons of extraordinary skill and imagination but merely to the ordinary workman who is capable of using the amount of skill and intelligence fairly to be expected from him in the practice of his art.

Stelos Co., Inc., v. Hosiery Motormend Corp. et al., supra, went up to the Supreme Court on writs of certiorari and the Supreme Court in 295 U. S. 237; 55 S. Ct. 746, affirmed the foregoing proposition and the opinion of the District Court for the Southern District of New York that claim 23 of the reissue patent involved in said Stelos case was invalid for want of proper disclosure.

In Helfreich v. Solo, 59 F. (2d) 525, 528, the Court held that a patent must disclose the proper proportion of the ingredients necessary to produce the result which was claimed in the patent. The Court states that the fact that testimony in the case discloses the proper proportions of kaolin to chalk will avail the patentee nothing, for his claims and his oral testimony cannot be permitted to broaden the disclosures of the specification.

In Zenithern Co. v. Art Marble Co., 56 F. (2d) 39, the Court held the process claim of the patent invalid for want of such sufficient disclosure as would enable one skilled in the art to produce the product by the disclosed process. The Court stated at page 42:

> "The whole argument for the validity of this claim comes from confusing the claim with the present product Zenithern. It seems to be a meritorious and perhaps a novel product deserving of a patent, but its proportions and the secret of its manufacture are not to be found in this patent. It is claimed that Welsh, the infringer, learned them by working in the Zenithern plant. The patent, had it made proper disclosure, would have told him all there was to know.

The situation in the Zenithern case supra parallels that in the instant case, in that the argument that claim 1 of the Smith patent here in suit is valid is based upon confusion of the actual disclosures of the Smith patent with the present method of operation of the Smith incu-

bator which was in fact discovered by Smith's witness Taggart four years after the Smith patent was granted. As admitted by Taggart, if the teachings of the Smith patent were followed in the method of hatching defined in claim 1 here in suit, that method would kill the embryos in the eggs instead of hatching them, because the temperature prescribed by Smith in his patent is "too hot".

In Hale Mfg. Co. v. Hafleigh & Co., 52 F. (2d) 714, 719, the Court held that a claim is invalid because not supported by the disclosure of the specification where extensive experiments would be necessary before it could be determined what proportions would produce a commercial result.

In United Drug Co. v. Ireland Candy Co., 51 F. (2d) 226, 230, the Court held that claims of a patent were invalid where from the teaching of the patent no one skilled in the art could construct and operate its device without experiments to determine the proper speed at which it must be driven. The Court states that it condemned indefiniteness of this nature in Cleveland Gas Burner v. American Heater Corp., 38 F. (2d) 760, 762, setting forth an excerpt from its opinion in that case with cited Supreme Court cases sustaining that proposition.

See also Steward et al. v. American Lava Co., et al., 215 U. S. 161; Beidler v. U. S., 253 U. S. 447; Reflectolyte Co. v. Luminous Unit Co., 20 F. (2d) 607.

In Diamond Rubber Company v. Consolidated Rubber Tire Company, 220 U. S. 428-436, 55 L. Ed. 527, the Court stated as to the requirements upon the inventor and patentee, "He must not put forth a puzzle for invention or experiment to solve".

In American Gas Accumulator Co. v. Prest-O-Lite Co., 9 F. (2d) 784, the Dallen patent 904,138 was held void for lack of disclosure as required by Section 4888 R. S., where it was shown that such material and the proportions designated in the formula given in the specification would not produce the results claimed.

In Roba et al. v. Martin Dennis Co., 263 F. 386, it was held that "Revised Statute 4888, and the purpose of the Patent Laws, require a full disclosure of the invention before the patent is granted, in order that the public may, at the expiration of the patent, have full use of the invention".

In Columbia Motor Car Co. v. C. A. Duerr & Co., 184 F. 893, the Court said "The public gained absolutely nothing from his invention, whatever it was. From the view of public interest it were even better if the patent had never been granted. • • • Its description must explain the invention itself, the manner of making it, the mode of putting it in practice. In the absence of knowledge of these points, the invention is not available to the public without further experiments and further exercise of inventive skill".

Smith failed to disclose the **only** essential factor of his method, viz., limitation of temperature of air in the incubator to 99° F. The undisputed fact that Smith and his corporations have, by high pressure salesmanship, induced the public to buy incubators resembling that shown in the patent in suit, is no evidence of patentability of the method claim here in suit. In Globe-Wernicke Co. v. Fred Macey Co., 119 F. 696, 56 C. C. A. 304, the Court said "The fact • • • that these book cases have gone into extensive use is due, as we think, to the elegant workmanship employed in their manufacture, and the convenience of having the sections separable, aided by the energy with which, as the bill states, they were pressed upon the market".

The proper test is comparison of Smith's patent disclosures with the disclosures of the prior art; from which it appears that "The public gained absolutely nothing from his invention, whatever it was. From the view of public interest, it were even better if the patent had never been granted". The effect of the grant was not only to grossly mislead those striving to learn the proper condi-

tions for incubation, but Petitioner Smith has used it to terrorize the public from constructive development of the art.

Point XI: During the Long Course of Litigation of said Smith Patent in Suit, Petitioner Has Persistently Misrepresented Scientific Facts Concerning Incubation and the Relation Thereof to the Disclosures of Said Patent, in Evidence and Arguments Presented to Courts, Including This Court.

An effective instrument in such misrepresentation is Petitioner's Exhibit 13. Petitioner's Exhibit 13 (Hall Rec. p. 126) is a "Graph Showing Development of Heat Units in Incubation", made by his expert witness Joseph I. Taggart, whose initials appear adjoining the date "12/22/28" thereon. It presents a fraction of truth, so as to be grossly misleading to the numerous Courts to which it has been presented since that date, with glib statements that the "heat units" referred to in said "Graph" are calories, of which "(.252 calories equal one B. T. U.)". See the first paragraph at the bottom of said "Graph".

The **blue** area on said "Graph" purports to represent the heat required, during the first ten days of incubation, to raise eggs to, and keep them at, the "incubating temperature" referred to in the legends thereon, which temperature is represented by the single horizontal line extending at the **top** of the **blue** area and **bottom** of the **red** area. The **red** area represents the "excess heat" given off by such eggs during the last eleven days of incubation.

That red area is more than three times greater than the blue, **misrepresenting** that the eggs **generate** more than three times as much heat as they absorb during the twenty-one days of incubation.

Under cross-examination Taggart admitted (Hall Rec. p. 46, f. 69-70) that said "incubating temperature" must be neither more nor less than ninety-nine degrees Fahrenheit. That the rise in temperature from the **tenth**

to the **eighteenth** day is but one degree Fahrenheit and that the **highest** temperature of the eggs is not attained until the **twenty-first day**, as shown by said Petitioner's Exhibit 13 (Hall Rec. p. 126).

Consequently, the vertical distance of 1.6 inches from the bottom of the "Red curve" to where the "Black Curve" crosses the vertical "18" day line on said "Graph" represents but **one degree F.**, and the **bottom** line of said "Graph" represents an **initial egg temperature** of 98.75° F.!

On the contrary, it is a matter of common knowledge that whether the eggs are gathered from a barn floor, freight station platform, or cold storage refrigerator; their **initial** temperature is more than 50° F. **lower** than 98.75° F.

> NOTE: It has been the practice in the art of incubation, for many years, to store eggs which are to be incubated, at a temperature not exceeding 45° F., until it is desired to incubate them, to prevent them from spoiling before they are introduced to the incubator.

Therefore, to present the **whole** truth the **blue** area of said "Graph" should be extended, vertically downward, more than **eighty inches** (50 times 1.6 inches) below the bottom line of said "Graph", to indicate the **actual** initial temperature of the eggs submitted to incubation.

When that is done the truth appears that the **quantity** of heat **generated** by the eggs and fully manifested by the **red** area of said "Graph" is but a **minute and negligible fraction** of the whole quantity of heat required to hatch eggs by the method of said claim 1, and the Petitioner's propaganda to the contrary urged for the past **19** years, first, upon the Commissioner of Patents, to obtain said Letters Patent, and, later, upon prospective customers, and, finally, upon numerous Courts, including this Court, was and is false and fraudulent.

Point XII: Contrary to Arguments on Behalf of Petitioner, the Method of Hatching of Claim 1 in Accordance With His Directions is Less Efficient Than Was Attained in Hastings' Incubator At the Davis Poultry Farm and Considerably Less Efficient Than the Different Method of Incubation and Hatching Practiced by the Respondents Hall Brothers.

In the trial of Samuel B. Smith v. F. J. LeMieux, La Plant Hatcheries, at Milwaukee, Wisconsin, on May 9, 1935, cited in "Brief for Petitioner", witnesses subpoenaed by Petitioner disclosed that use of his "method of hatching" during the hatching season of the year 1935 resulted in hatching not more than 35% of all of the eggs set.

In contrast: It is noted that since the Fall of the year 1930 the only method of hatching used by Respondents, Hall Brothers, was effected in a hatching chamber containing only eggs which have reached the eighteenth day of their incubation (Hall Rec. p. 41, f. 63-64), which hatching chamber is separate and apart from any chamber containing eggs in any earlier stage of incubation. (Hall Rec. p. 64, ff. 95-96). The evidence (Hall Rec. p. 64, f. 96) that the use of that separate hatching method by Respondents has enabled them to hatch between 85% and 90% of the eggs set, was undisputed.

THIS COURT DECEIVED.

In view of the use of that separate hatching method not only by these Respondents but by many other defendants named in suits by your Petitioner; this Court was deceived to the erroneous belief, (set forth in Hall Rec. p. 100, f. 148) "the eggs passed into the more advanced stages of incubation, *reaching their highest temperature about the seventeenth day*" (italics ours). That statement is contradicted by the admissions of Petitioner's witness Taggart (Hall Rec. p. 46, ff. 69-70) in his testimony re Plaintiff's Exhibit 13 (Hall Rec. p. 126), and clearly and specifically to the effect

that even at the end of the **eighteenth** day the eggs have only reached a temperature of 100° F., whereas, the **highest** temperature, of 105° F., is not reached until the twenty-first day, as shown by said Exhibit 13.

Re Petitioner's "POINT I".

On page 15 of "Brief for Petitioner" in interpretation of Smith's claim 1, it is stated:

> "In order to secure the benefits of the invention, intelligent use must be made of staged incubation so as to secure an approximate balance between the endothermic and exothermic eggs. A mere hit and miss setting of eggs of varying ages will not suffice, for if only a small percentage of the eggs is in one stage, and the great mass in another, obviously the preponderance of cold, or hot, eggs will destroy the necessary balance which should be maintained."

There is no suggestion in Petitioner's claim 1, or the specification of the patent in suit, of any such "balance between the endothermic and exothermic eggs". On the contrary, as clearly shown in Fig. 3 of Petitioner's patent, the proportion of "cold" eggs to "hot" eggs is indicated by the fact that sixty trays are provided for the former and only fifteen trays provided for the latter. Certainly, there could be no balance of temperature between the cold and hot eggs under such conditions.

As fully set forth supra, with reference to Petitioner's Exhibit 13, the heat **generated** by the hot eggs is a negligible factor in comparison with the heat **required** by the cold eggs when arranged as specified and shown in Petitioner's patent in suit.

The essential factor is the **artificial heat** furnished by the "Coils of heating pipe 23" described in line thirty-six on page 2 of said Smith patent, and shown in the upper portion of Fig. 3 thereof, and such heat **must** be controlled and varied **automatically**, to maintain the critical temperature of the air.

It is to be particularly noted that as testified in the Hall case (Hall Rec. p. 58, f. 87), Hastings' Brooklyn incubator included **both** a "mercury controlled governor" and other "**thermostatic** control" means for precisely controlling the gas burning heater for the air in the incubator, for the purpose of precisely controlling the temperature of that air (Hall Rec. p. 59, f. 88).

Petitioner adopted that "thermostatic control" feature of Hastings' incubator, six years later, in the **specification** of his application for the patent in suit filed October 26, 1916, (p. 2, line 96 et seq.) but only **illustrated** an incubator structure devoid of any such controlling means; the only means therein shown for controlling the steam heating pipes 23 being the small valve indicated at the left hand side of Fig. 3, which is not reference marked or described, but is obviously intended to be only manually operated.

Moreover, although Petitioner's patent in suit only shows an incubator inclosure formed of **single** uninsulated walls; Petitioner later adopted in his commercial structure and continues to use the idea of forming an incubator inclosure with **double** walls having heat insulating material between them, which was embodied in Hastings' Brooklyn incubator, as shown in Cooley's Exhibit drawing D-D, infra, and shown in Hastings' application drawing (Hall Rec. p. 283), and reproduced on page 24 of "Brief for Petitioner".

PRIOR ART.

A copy of each of the prior art patents cited is included in pages 307 to 415 in the Transcript of Record in the Cooley case, which is the book containing Hall's Exhibit F, including those reviewed by Mr. Justice Stone in Plaintiff's Exhibit 2 (Hall Rec. pp. 1[illegible]-110, f. 162). As there stated by Mr. Justice Stone:

> "The German patent, Stulik, No. 155,917; issued in 1901, disclosed the arrangement of trays of eggs in staged incubation in an enclosed column or stack, with

> the endothermic eggs at the bottom. The eggs were subjected to a rising column of heated air, which was allowed to escape at the top of the chimney. There was no forced draft of air, no circulation or re-circulation of air, and in consequence no carrying of heat units from the more advanced eggs at the top to the less advanced eggs at the bottom."

The earlier Winkler U. S. Patent No. 286,756 (cited Hall Rec. p. 110, f. 162) also discloses such staged incubation in lines 52-61 on page 2 thereof, Cooley Rec. p. 318. Therefore, Mr. Justice Stone concluded (Hall Rec. p. 110, f. 163) that the distinction between the prior art disclosed to the Supreme Court and the subject matter of claim 1, was the "application of a continuously circulating current of air to eggs in staged incubation".

However, the proofs on behalf of Respondents in this case show that the Petitioner was not even the originator of that principle of combination of prior art ideas. It was originated by Milo M. Hastings.

> The evidence upon which the decision of the Second Circuit Court is predicated is clearly conclusive that Hastings constructed and operated **three** incubators embodying that same principle; successively at Brooklyn, Muskogee, and Port O'Connor, and all **before** the "Spring of 1914", the date alleged by Petitioner for his first conception of the invention in suit.

PETITIONER'S PRIOR ART CONTRIBUTION.

That principle, of combining staged incubation with a continuously circulating current of air, was not only known in the prior art, supra, but practiced by the Petitioner Smith in the year 1912, at Attica, Ohio, more than four years before he filed his application for the patent here in suit. He was commercially operating incubators at Attica

and had one, of 15,000 egg capacity, wherein a fan was driven by a steam engine.

Petitioner Smith testified concerning that incubator, as appears on page 219 in the Record of the Cooley case (Hall Exhibit F), as follows:

> "RXQ166. In other words you had stage incubation at Attica in 1912. A. Yes.
>
> RXQ167. What was the capacity of that forced draft incubator at Attica? A. I could not say exactly now, but something like 15,000.
>
> RXQ168. Was the fact that hatches as you say were not good due to the fact that you did not have sufficient fan capacity? A. The fan capacity in conjunction with the construction of the machine.
>
> RXQ169. Just how was it constructed? A. The heater and fan were at one end and it blew the air across the top and down through the trays and came down to the bottom and returned to the fan and heater.
>
> RXQ170. In this Attica machine did the current of air pass through the trays? A. You mean with the steam engine?
>
> RXQ171. The steam-engine-operated one. A. Yes.
>
> RXQ172. So that in that device you had the current of air passing through the eggs from the most advanced stage to those of a lesser-advanced stage of incubation? A. Yes."

Point XIII: Respondents Have the Right to Rely Upon Disclosures of the Official Record of the Hastings Abandoned Application, Found in Halls' Exhibit F, as Evidence of Prior Invention or Discovery Relative to That of the Smith Claim in Suit.

In U. S. Blind Stitch Mach. Corp. v. Reliable Mach. Works, Inc., an opinion was filed November 6, 1933, by the Circuit Court of Appeals for the Second Circuit, as reported

in 67 F. (2d) 327-329. It appears from that opinion that appellee pleaded anticipation of the patent in suit by a prior abandoned application and practical use by appellee's customer Pomeranz of the disclosures shown in that application. That application was filed on June 20, 1925, disclosing a machine for treating furs and claiming both the apparatus and the method of its use, but, following rejection upon citation of a prior patent, that application was abandoned on May 2, 1927.

The Circuit Court of Appeals for the Second Circuit states in its opinion at page 328:

> "We think that claims 1 and 2 are anticipated by the Pomeranz previous application, which was filed June 20, 1925. That petition for a patent provided for an improvement in a machine for fur electrifying, ironing, and curling. The invention is established by the testimony of the inventor, his patent draftsman and attorney, as well as by documentary proof, to wit, the abandoned application and original drawing. This was filed nearly three years before the patent here in suit. • • • The machine was used by Pomeranz in his business in 1925 and thereafter to 1929 and was dismantled when he obtained the machine from the appellee. Pomeranz testified that he had an actual, full-size machine made prior to the date of appellant's application. The machine was shown to various people who came into the place of business and was operated on furs from 1925 to 1929. • • • It was in open and notorious use for anyone to see who visited the factory. There is ample corroboration of this use. No secrecy was maintained as to it."

The fact situation in the instant case parallels precisely the state of facts in the cited case. In the instant case, the invention of Hastings is established by the testimony of the inventor (Hastings), by Walter B. Davis, and by Mrs. Wal-

ter B. Davis, as well as by documentary proof, to wit, the abandoned application which was filed in the United States Patent Office on May 3, 1911. This date is three years before the earliest date of conception claimed by Smith herein. As in the Second Circuit case, in the instant case a machine was used by Hastings and Davis at the Davis Poultry Farm in 1911 and thereafter dismantled. Hastings, like Pomeranz, testified that he had an actual, full size machine made more than two years prior to the date of conception of Smith. As in the cited case, the Hastings machine was shown to various people who came into the place of business of Davis and was used to successfully hatch chicks in 1911. As in the cited case, the Hastings machine was in open and notorious use at the Davis Poultry Farm for anyone to see who visited the Farm. It was testified by both Mr. and Mrs. Davis that hundreds and hundreds of people visited the Davis Poultry Farm. As in the cited case, no secrecy was maintained as to the construction and method of operation of the Hastings incubator built and used on the Davis Poultry Farm.

Said decision of the Circuit Court of Appeals for the Second Circuit cites Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 358, 48 S. Ct. 380, 72 L. Ed. 610.

In the latter decision, which was rendered April 9, 1928, defendant contended that the claims of the patent in suit for a process of curing rubber were anticipated by prior use by Kratz. Plaintiff contended that what Kratz did was merely abandoned laboratory experiments. In line 13 et seq. on page 383, it was held that "A process is reduced to practice when it is successfully performed". In line 21 et seq. on page 384, it was held that "It is a mistake to assume that reduction to use must necessarily be a commercial use. If Kratz discovered and completed, as we are convinced that he did, the first use of D. P. G. as an accelerator in making vulcanized rubber, he does not lose his right to use this discovery when he chooses to do so, for scientific purposes or purposes of publication, because he does not

subsequently sell the rubber thus vulcanized, or use his discovery in trade, or does not apply for a patent for it. It is not an abandoned experiment because he confines his use of the rubber thus produced to his laboratory or to his lecture room. It is doubtless true that Kratz, by his course in respect to his discovery as to the use of the D. P. G., has abandoned any claim as against the public for a patent, but that is a very different thing from saying that it was abandoned as against a subsequent discoverer or patentee".

The Court held the claims in suit invalid because of Kratz' prior uncommercial use.

Therefore, it is submitted that the foregoing decisions support Respondents' contention that Hastings' abandoned application, exemplified by Defendants' Exhibit F, plus evidence of the use of that invention effected by Hastings and Walter B. Davis, et al., is such anticipation of claim 1 of the patent in suit as to render the latter invalid and void.

Point XIV: No Use of a Method or Process Which Accomplishes the Result Sought Can Be Legally Classed As an Abandoned Experiment.

In Midland Flour Milling Co. v. Bobbitt (70 F. (2d) 416), on page 419, it is stated:

> "It is true that invention is not anticipated by experimental efforts which are abandoned before accomplishing the event achieved by the invention. In the instant case the experiment was successful, and the dust collector as installed in plaintiff's alfalfa mills successfully accomplished what he claims to have accomplished by his patent. Successful use of an art or instrument is not an experimental use, and an invention or discovery is not to be considered as an abandoned experiment merely because it was not applied to commercial use. Thomson Spot Welder Co. v. Ford Motor Co. (D. C.), 268 F. 836, affirmed (C. C. A. 6th), 281 F. 680, affirmed 265 U. S. 445, 44 S. Ct. 533, 68. L. Ed.

1098; Freydberg Bros. v. Hamburger (D. C.) 17 F. (2d) 300; Ficklen v. Harding (C. C. A. 2d), 273 F. 179; Buser v. Novelty Tufting Machine Co. (C. C. A. 6th), 151 F. 478; Brush v. Condit, 132 U. S. 39, 10 S. Ct. 1, 33 L. Ed. 251."

In International v. Gaylord, 140 U. S. 55; 35 L. Ed. 347; 11 S. Ct. 716, the Supreme Court of the United States held:

> "It is not experimental use where an inventor practises his art generally, teaching it to others and receiving pay therefor."

See also Smith v. Sprague, 123 U. S. 249; Consolidated v. Wright, 94 U. S. 92; Egbert v. Lippman, 104 U. S. 333; Elizabeth v. Nicholson, 97 U. S. 126.

Therefore, as Respondents have proven that Milo M. Hastings not only taught others to practice the art or method of hatching, of the Smith claim 1 here in suit, including Walter B. Davis and his employes at the Davis Farm, but certainly accomplished the successful and successive hatching of chicks on that Farm, which was a commercial use of that method both in the sense that Hastings was paid for it by Davis and in the sense that Davis used the chicks commercially; that use cannot legally be held to be an abandoned experiment, but was clearly an anticipation of said claim, rendering the latter invalid and void.

Point XV: Respondents Do Not Infringe.

The testimony of the Respondent A. B. Hall was not controverted or denied:

First: That Respondents have not, since the Fall of the year 1930, used any method of hatching whereby eggs were hatched in any chamber containing eggs at any earlier stage of incubation. (Hall Rec. p. 64, f. 95.)

Second: That, since the Fall of the year 1930, the only

method of hatching used by Respondents was affected in a hatching chamber containing only eggs which have reached the end of the eighteenth day of their incubation (Hall Rec. p. 41, f. 63) which hatching chamber is separate and apart from any chamber containing eggs in any earlier stage of incubation. (Hall Rec. p. 64, ff. 95-96.)

Third: That the temperature of the atmosphere in the incubators used by Respondents since the Fall of the year 1930 has been 99° F. (Hall Rc. p. 64, f. 95.)

Fourth: That the percentage of moisture in the air in the incubators used by Respondents since the Fall of the year 1930 has run from 35 to 45% humidity. (Hall Rec. p. 64, f. 95.)

Fifth: That the temperature of the atmosphere in the separate hatchers used by Respondents since the Fall of the year 1930 has been 98° F. (Hall Rec. p. 64, f. 95.)

Sixth: That the percentage of moisture in the air in the separate hatchers used by Respondents since the Fall of the year 1930 has been from 65 to 80% humidity. (Hall Rec. p. 64, f. 95.)

Seventh: That the method of hatching used by Respondents since the Fall of the year 1930 has the advantage that they can control the temperature in the incubators at a different degree than the temperature in the separate hatchers. (Hall Rec. p. 64, f. 95.)

Eighth: That the method of hatching used by Respondents since the Fall of the year 1930 has the advantage that they can separately control the percentage of moisture in the incubators and in the hatchers. (Hall Rec. p. 64, f. 95.)

Ninth: That the advantages above stated are mani-

fested by from 2 to 5% better hatches. (Hall Rec. p. 64, f. 96.)

Tenth: That the use of that separate hatching method by Respondents has enabled them to hatch between 85 and 90% of the eggs set. (Hall Rec. p. 64, f. 96.)

As illustrated by Petitioner's Exhibit 13 (Hall Rec. p. 126), during the twenty-one "days of incubation", the eggs are in two distinct stages, referred to in the claim in suit respectively as "the less advanced stage" and "the more advanced stage of incubation". The former stage comprises the first ten days, during which the eggs are absorbing heat from the surrounding air in the closed chamber; such "less advanced stage" being indicated by the area colored blue in said exhibit. "The more advanced stage of incubation" extends from the tenth to the end of the twenty-first day, during which the eggs are generating heat to the air surrounding them in said closed chamber, as indicated by the area colored red in said Exhibit 13. Consequently, as appears from said diagram, all eggs which have been subjected to incubation for eighteen days are in said "more advanced stage of incubation", generating heat, but are in a condition **three days remote from hatching.**

As testified by Petitioner's witness Taggart (Hall Rec. p. 46, f. 69-70) at the end of the eighteenth day of incubation the eggs have only reached a temperature of 100° F., whereas, the **highest** temperature, of 105° F., is not reached until the twenty-first day, as shown by said Exhibit 13.

Consequently, Respondents' method of hatching above characterized is essentially different from that of the Smith patent and claim 1 in suit in that all of the eggs which have reached the eighteenth day of incubation are removed and isolated from any eggs in the less advanced stage and, therefore, not in the heat interchanging relation with the eggs in the less advanced stage required by the specific terms of said claim in suit, and the heat generated by those eggs from the eighteenth day to the twenty-first day is not carried to

the eggs in the "less advanced stage" as required by the terms of said claim.

Therefore, the method of hatching employed by the Respondents "since the Fall of 1930" certainly does not include the two features of that method claim referred to on page 8 hereof as follows:

(j) maintaining in the same chamber **during the hatching**, eggs of "more advanced stage of incubation" with others "in a less advanced stage".

(k) carrying "units of heat" from the eggs in the more advanced stage of incubation to those "in a less advanced stage", **during the hatching**.

Therefore, Respondents certainly have not infringed said claim by the only method of hatching they have employed **"since the Fall of 1930"**.

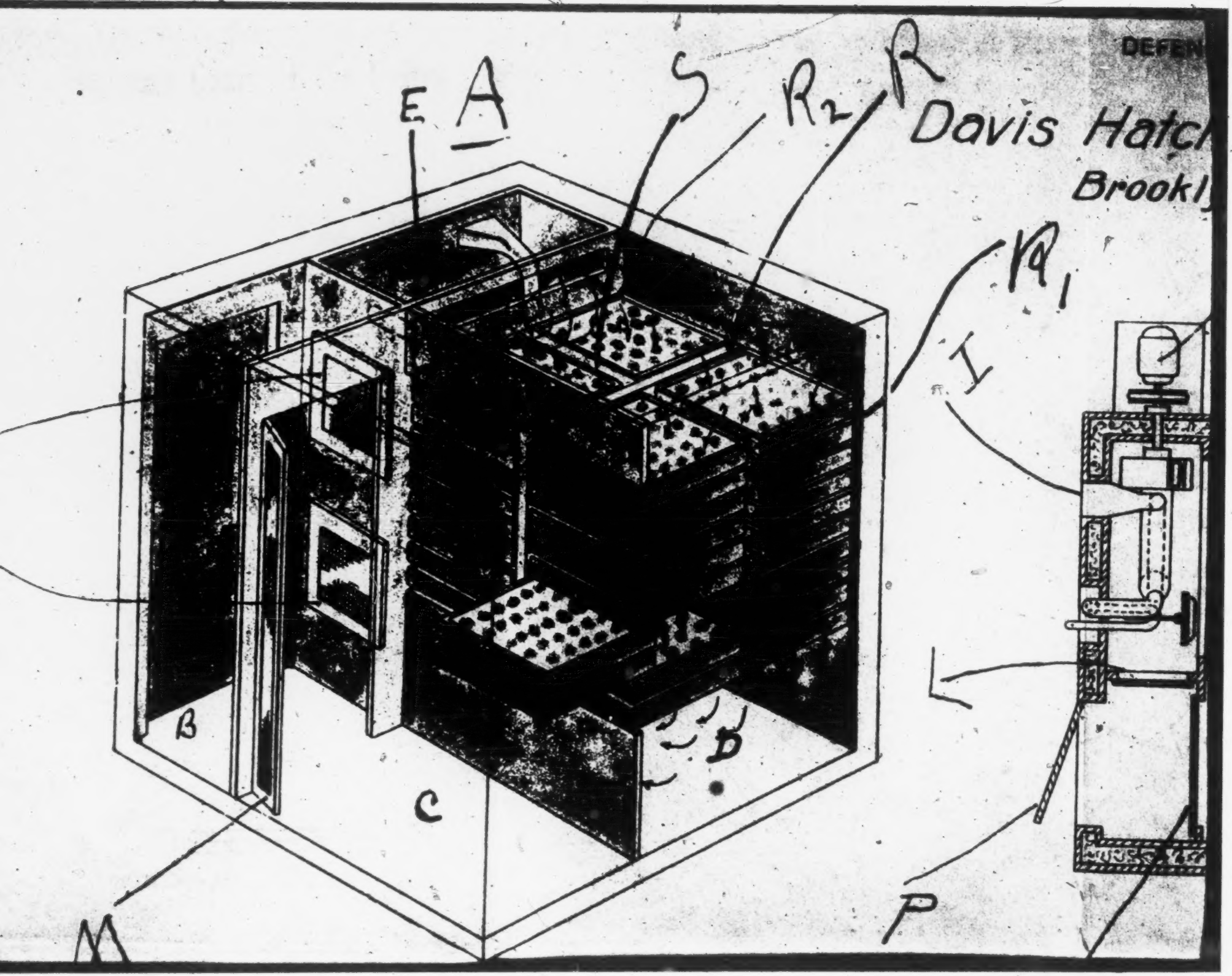
Moreover, Respondents have not **at any time** infringed any legal right of the Petitioner, because the claim in suit is invalid and void for the several reasons hereinbefore set forth at length.

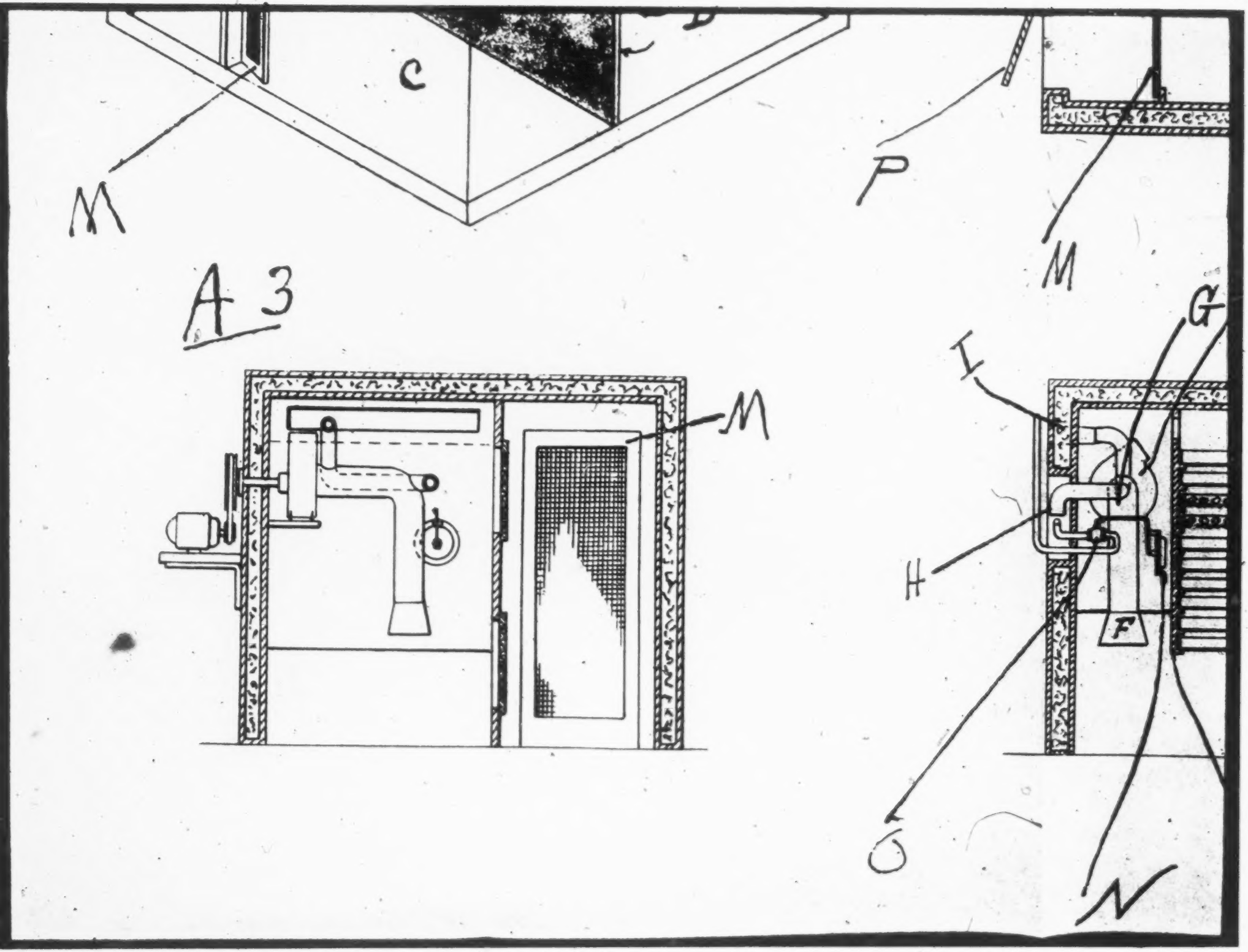
CONCLUSION.

Therefore, the unanimous decision of the three judges of the Second Circuit, in the instant case, was amply justified by the new evidence presented to them, and should be sustained by this Court.

Respectfully submitted,

ARTHUR E. PAIGE,
THOMAS G. HAIGHT,
FRANK E. PAIGE,
Counsel for Respondents.

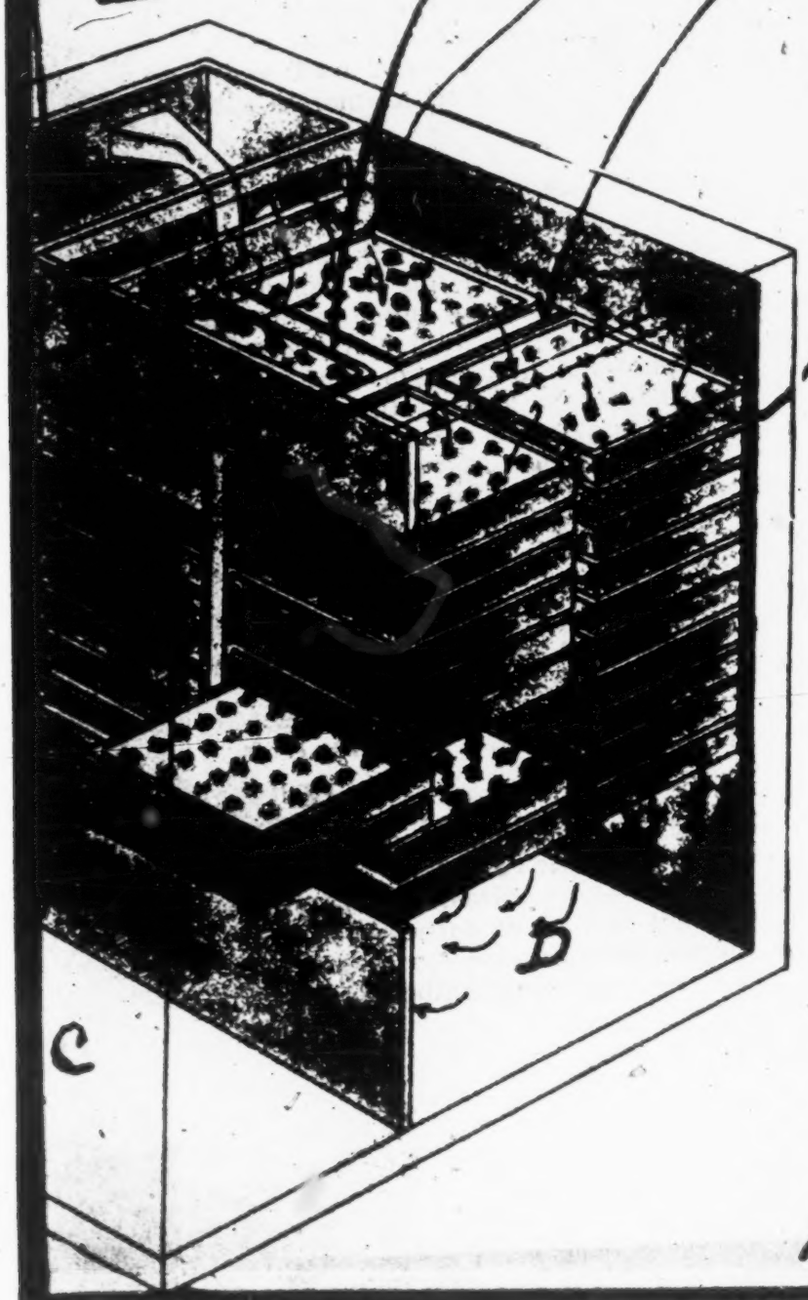

E
A
S
R2
R
Davis Hatch
Brookl
R1
I
B
C
D
M
P

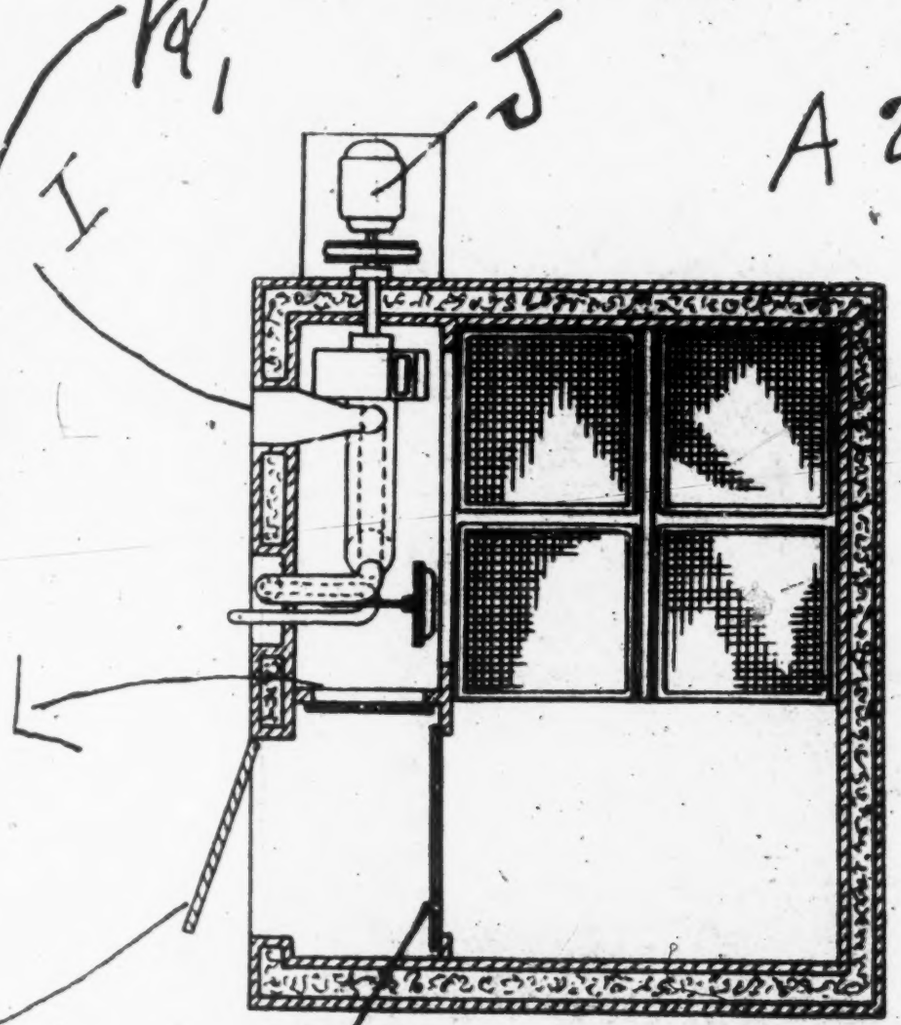

C
M
P
M
A 3
M
G
I
H
F
G
N

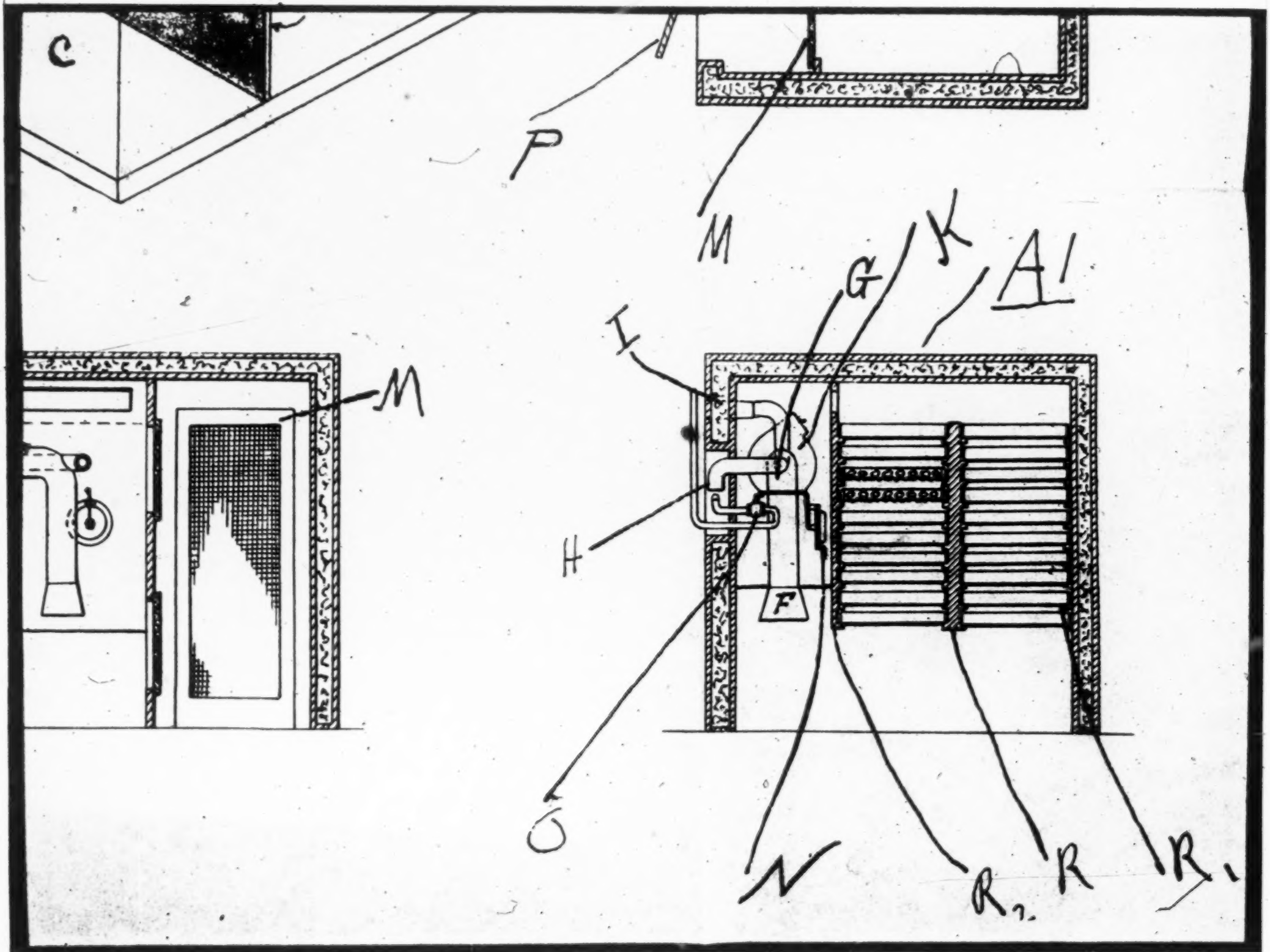
DEFENDANT'S EXHIBIT D-D

257

Davis Hatchery of 1910
Brooklyn N.Y.






C
P
M
G
K
A1
I
M
H
F
G
N
R2
R
R1